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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,083	02/01/2001	Fred Smith	218-010137	6320

7590

02/24/2004

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EXAMINER

LEE, SEUNG H

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/775,083

Applicant(s)

SMITH, FRED

Examiner

Seung H Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Receipt is acknowledged of the response filed on 06 May 2003, which has been entered in the file.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 26 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 26, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception

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and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

5. Claims 21-37 are rejected under 35 U.S.C. 102(g) as being clearly anticipated by Keohane (US 6,364,206).

Keohane teaches a fuel dispensing system comprising a fuel dispenser including a customer interface for conducting a transaction including a lottery ticket purchase, a payment acceptor for receiving a payment for the transaction, and a lottery ticket dispenser for dispensing lottery tickets; and a control system operatively associated with said fuel dispenser and adapted to cause said lottery ticket dispenser in said fuel dispenser to dispense a lottery ticket to a customer in response to receiving the payment for the transaction through said payment acceptor in said fuel dispenser, the payment acceptor comprises a card reader for reading payment information from a customer payment card, the customer payment card is a credit card and said control system is further adapted to communicate with an outside credit authorization network to receive credit authorization for the transaction, the payment acceptor comprises a cash acceptor for receiving a cash payment from the customer, the control system is further adapted to communicate the transaction information related to the purchase of the lottery ticket to a lottery controller, the lottery ticket dispenser in said fuel dispenser is adapted to dispense a plurality of lottery ticket types, the lottery ticket dispenser is adapted to dispense a lottery ticket having customer-selected play numbers and said customer interface in said fuel dispenser is adapted to allow a customer to input said customer-selected play numbers, the lottery ticket dispenser in said fuel dispenser is adapted to dispense a preprinted lottery ticket type, the lottery ticket dispenser in said

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fuel dispenser is adapted to dispense a random-number lottery ticket type, the transaction indicia communicated to the customer and to said lottery ticket dispenser by said fuel dispensing system. Koehane teaches a method of selling lottery tickets comprising prompting a customer to conduct a lottery ticket purchase in conjunction with the fueling transaction; receiving input from the customer regarding the lottery ticket purchase; conducting the fueling transaction; effecting payment at said fuel dispenser for a cost associated with the lottery ticket purchase and a cost associated with the fueling transaction; dispensing a lottery ticket to the customer corresponding to the lottery ticket purchase, the fuel dispenser is adapted to perform said dispensing step, a separate lottery ticket dispenser is adapted to perform said dispensing step, a customer interface supporting the input of information by the customer in said receiving step, the customer interface supports selection of multiple lottery ticket types, including preprinted number, random number, and customer-selected number lottery ticket types, the customer interface of said fuel dispenser is adapted to permit the customer to enter a desired set of play numbers in association with the purchase of a customer-selected number lottery ticket (see claims 1-38; Fig. 5; col. 7, line 36- col. 8, line 9; col. 9, lines 24-38).

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 38, 39, 42, and 43 are rejected under 35 U.S.C. 102(e) as being anticipated by Keohane.

In addition to teachings of Keohane as discussed above, he also teaches a lottery ticket purchase transaction (526) is engaged in after a fuel transaction (522) has been initiated or simultaneous (see col. 9, lines 24-38).

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 40, 41, 44, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keohane in view of Maloney et al. (US 6,119,932)(hereinafter referred to as 'Maloney').

The teachings of Keohane have been discussed above.

Although, Keohane teaches the fuel dispensing system having a lottery ticket transaction, he fairly teaches a lottery ticket purchase transaction is authorized by an operator based upon an age of a customer.

However, Maloney teaches an identification verification system where an operator is employed to enforce an age limitation for sale of lottery tickets (see Figs. 1 and 2; col. 4, line 61-col. 5, line 11).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Maloney to the teachings of Keohane in order to prevent the sales of lottery to the underage customer wherein the sales of the lottery ticket to underage customers are prohibited, and therefore an obvious expedient.

***Allowable Subject Matter***

10. The favor result of interference procedure regarding instant application, claims 21-45 would be allowable over prior art of record.

11. The following would be a statement of reasons for the indication of allowable subject matter:

The prior art of record, taken alone or in combination, fails to teach a fuel dispensing system comprising; a fuel dispenser including a customer interface for conducting a transaction including a lottery ticket purchase, a payment acceptor for receiving a payment for the transaction, and a lottery ticket dispenser for dispensing lottery tickets, and a control system associated with the fuel dispenser to cause the lottery ticket dispenser in the fuel dispenser to dispense a lottery ticket to a customer in

response to receiving the payment for the transaction through the payment acceptor in the fuel dispenser as set forth in the claims.

### ***Additional Remarks***

12. Upon receiving response including the amendment overcoming the discussed rejections above, the prosecution of the instant application would be suspended in order to invoke the interference.

### ***Conclusion***

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Seung H. Lee whose telephone number is (703) 308-5894. The examiner can normally be reached on Monday to Friday from 7:30 AM to 4:00 PM.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax-phone number for this group is (703) 308-5841 or (703) 308-7722.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [michael.lee@uspto.gov].

*All Internet e-mail communications will be made of record in the application file.*  
*PTO employees do not engage in Internet communications where there exists a*

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*possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

*ShL*  
Seung H. Lee  
Art Unit 2876  
February 10/2004

*Diane I. Lee*  
**DIANE I. LEE**  
**PRIMARY EXAMINER**